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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,701	11/09/2001	Richard M. Weiss	WR-2	7539

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NEW YORK, NY 10020-1105

EXAMINER

CHAPMAN JR, JOHN E

ART UNIT	PAPER NUMBER
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2856

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,701

Applicant(s)

WEISS ET AL.

Examiner

John E Chapman

Art Unit

2856

AW

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) 15-20, 41-46 and 67-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14, 21-40, 47-66 and 73-140 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restriction

1. Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that claims 17, 18, 43, 44, 69 and 70 link Groups I and II. This is not found persuasive because a linking claim is a claim which, if allowed, acts to prevent restriction between inventions that can otherwise be shown to be divisible. See MPEP § 809.03. In the present case, the allowance of claim 17, for example, would not entail the allowance of either claim 1 or claim 15, and therefore would not prevent restriction between the inventions. Rather, claim 17 is a combination claim (i.e., the combination of measuring a restoring force and measuring the frequency of vibration), which does not set forth the details of the subcombination of claim 1 (i.e., measuring the maximum out-of-plane displacement). See MPEP § 806.05(c). Consequently, the allowance of claim 17 would not prevent restriction between the inventions and would not necessitate the rejoinder of claim 1.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 15-20, 41-46 and 67-72 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 27-40, 53-66, 80-93, 100-113 and 120-133 drawn to a method and an apparatus for determining a preferred angular orientation of a golf club shaft, classified in class 73, subclass 579.

- II. Claims 21-25, 47-51, 73-77, 79, 94-98, 114-118, 134-138 and 140 drawn to a method and an apparatus for determining a preferred angular orientation of a golf club shaft, classified in class 73, subclass 579.
- III. Claims 26, 52, 78, 99, 119 and 139 drawn to a method and an apparatus for determining a preferred angular orientation of a golf club shaft, classified in class 73, subclass 579.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility, since the maximum out-of-plane displacement can be measured by means other than detecting reflected energy beams. Conversely, reflected energy beams can be detected without measuring the maximum out-of-plane displacement. See MPEP § 806.05(d).

5. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility, since the maximum out-of-plane displacement can be measured without using an electromagnet to initiate vibratory motion. Conversely, an electromagnet can be used to initiate vibratory motion without measuring the maximum out-of-plane displacement. See MPEP § 806.05(d).

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6. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility, since reflected energy beams can be detected without using an electromagnet to initiate vibratory motion. Conversely, an electromagnet can be used to initiate vibratory motion without detecting reflected energy beams. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

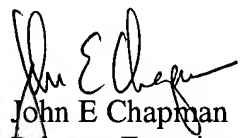
8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E Chapman whose telephone number is (571) 272-2191. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John E Chapman
Primary Examiner
Art Unit 2856